<u>**REMARKS**</u>

In the Office Action, the Examiner indicated that claims 1 through 16 are pending in the application and the Examiner rejected all claims.

<u>**Claim Rejections, 35 U.S.C. §102**</u>

In item 3 on page 2 of the Office Action, the Examiner rejected claims 1, 2, 4-6, 8-10, 12-14 and 16 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,658,402 to Dutta ("Dutta").

<u>**The Present Invention**</u>

The present invention provides a method for automatically bookmarking a URL <u>specified by a web author</u> when a user of a web browser attempts to bookmark a different page or when a process updates bookmarks based on either the HTTP 301 return code or the HTML meta refresh markup. In accordance with the present invention, a web page author places an "<u>alternate bookmark directive</u>" in the page (HTML or XML format) associated with a particular URL. When this "alternate bookmark directive" in the HTML or XML file is received by the web browser or by a process updating bookmarks, and the user of the browser attempts to bookmark the URL being viewed or the process is verifying a bookmark, then either the browser is instead directed to bookmark the <u>specifically predetermined</u> alternate URL from the tag or the process modifies the bookmark being verified using the <u>specifically predetermined</u> alternate URL from the tag. In a preferred embodiment, the bookmarked page being viewed or verified is an internal web page of the website, and the <u>predetermined</u> alternate bookmark directive directs the browser to bookmark the URL for the home page of the website or the verification process to update the bookmark to the URL for the home page of the website.

U.S. Patent No. 6,658,402 to Dutta

U.S. Patent No. 6,658,402 to Dutta ("Dutta") teaches a system, method and program whereby a hyperlinking site-map of a server is created and stored along with a bookmark for a page. On clicking a bookmark, if the page is not found, another close page is obtained by the client. If an attempt to reach a particular page fails because the page is no longer existent on the

site, the links in the chain represented by the site map are followed back from that page to the root

page.

U.S. Patent No. 6,041,360 to Himmel et al.

U.S. Patent No. 6,041,360 to Himmel et al. ("Himmel") teaches access to the Internet

using dynamic bookmarks. The Examiner relies upon Himmel for an asserted teaching of the

dynamic updating of bookmarks using encoding in XML as a web page representation.

The Cited Prior Art Does Not Anticipate the Claimed Invention

The MPEP and case law provide the following definition of anticipation for the purposes of

35 U.S.C. §102:

> "A claim is anticipated only if each and every element as set forth in the claim is
> found, either expressly or inherently described, in a single prior art reference."
> MPEP §2131 citing *Verdegaal Bros. v. Union Oil Company of California*, 814
> F.2d 628, 631, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987).

As noted above, the present claimed invention includes the insertion of <u>a predetermined</u>

<u>alternative bookmark directive</u> in an encoded web page representation associated with a target

URL that is being bookmarked. This <u>predetermined</u> alternative bookmark directive causes the

web browser to bookmark the alternative URL instead of the target URL when a user of the web

browser attempts to bookmark the target URL. It is specific, i.e., the web designer plans it ahead

of time. This occurs regardless of whether or not the target URL is available.

Dutta contains no such teaching. Dutta provides a useful invention in that a site map is established so that, <u>if a particular web page that is bookmarked is no longer available</u>, the site map can be used to track back to a previous web page that is available. This is a good and helpful idea; however, it does not teach or suggest the present invention, whereby a <u>predetermined</u> alternative bookmark directive is encoded in web pages, and this <u>predetermined</u> alternative bookmark directive automatically causes any attempt to bookmark the target URL to actually bookmark <u>the predetermined</u> alternative URL. In preferred embodiments that are claimed in dependent claims, the <u>predetermined</u> alternative bookmark is the homepage of the website associated with the target URL.

Each of the independent claims (and thus all dependent claims as well), specifically claim the insertion of an alternative bookmark directive as defined in the specification. Since the claims specifically claim this element, and since there is no teaching (nor suggestion) of these claimed elements in Dutta, claims 1, 2, 4-6, 8-10, 12-14 and 16 (and all claims depending therefrom) patentably define over Dutta. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 1, 2, 4-6, 8-10, 12-14 and 16 based on Dutta.

<u>Rejection of Claims under 35 U.S.C. §103(a)</u>

On page 6 of the Office Action, the Examiner rejected claims 3, 7, 11 and 15 under 35 U.S.C. §103(a) as being unpatentable over Dutta in view of U.S. Patent No. 6,041,360 to Himmel et al.

<u>The Examiner has not Established a *prima facie* Case of Obviousness</u>

As set forth in the MPEP:

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skilled in the art, to modify the reference or to combine reference teachings.
<u>MPEP 2143</u>

The Examiner relies upon U.S. Patent No. 6,041,360 to Himmel for an alleged teaching of the use of encoding in XML as a web page representation in connection with dynamic updating of bookmarks. Applicant does not deny that Himmel teaches that XML may be used to represent a web page. However, nothing in Himmel teaches or suggests the encoding of a predetermined alternate bookmark directive in any form (e.g., XML or HTML). Himmel simply discloses the updating of a traditional bookmark because the browser sees itself being redirected by the response headers when fetching a page, or it sees standard data markup in the page that is used in naming or classifying the bookmark. Without any teaching or suggestion of the encoding of a <u>predetermined</u> alternate bookmark directive as is claimed in each of the claims of the present invention, the addition of Himmel provides no basis for rejection of the claims. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 3, 7, 11 and 15 under 35 U.S.C. §103.
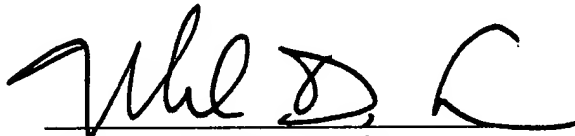
<u>Conclusion</u>

The present invention is not taught or suggested by the prior art. Accordingly, the

Examiner is respectfully requested to reconsider and withdraw the rejection of the claims. An

early Notice of Allowance is earnestly solicited.

The Commissioner is hereby authorized to charge any fees associated with this

communication to Deposit Account No. 09-0461.

<div align="center">Respectfully submitted</div>

2/14/05
Date

Mark D. Simpson, Esquire
Registration No. 32,942

SYNNESTVEDT & LECHNER LLP
2600 ARAMARK Tower
1101 Market Street
Philadelphia, PA 19107

Telephone: (215) 923-4466
Facsimile: (215) 923-2189

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